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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY, DOCKET NO.
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09/283,375 04/09/99 BOULIGNY

V FRK36

EXAMINER

PM82/1124

KRAMER, D

ART UNIT

PAPER NUMBER

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3652

DATE MAILED:

11/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/289,375

Applicant(s)
Bouligny

Examiner
Dean J. Kramer

Group Art Unit
3652



☒ Responsive to communication(s) filed on Oct 11, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-4, 6-16, and 18-36 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-3, 6-10, 13-15, 18, 21-23, and 29-32 is/are allowed.

☒ Claim(s) 4, 11, 12, 16, 19, 20, 24-28, and 33-36 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The amendment received October 11, 2000 and the remarks presented therewith have been carefully considered. However, they are not deemed to be fully persuasive.

2. Claims 4, 11, 12, 16, 19, 20, 24-28, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4, 16, and 24 are confusing in that it is unclear whether the "sleeve" (recited in claim 4, line 1; claim 16, line 1; and claim 24, line 6) is meant to be in addition to the upper and lower sleeves already recited in claims 1, 15, and 24, respectively.

Further, claims 12 and 20 are exact duplicates of claims 6 and 18, respectively.

Also, there is no clear antecedent basis for "said fill-up and circulating tool" as recited in the last two lines of claim 35.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 33-36, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Guess in view of Hawkins, III.

Guess shows a gripping tool comprising a barrel (10) with an axial fluid pathway (23) and a tapered section (24) having planar surfaces (43), a plurality of slips (40) having gripping members (41), a flexible moving assembly (31) for causing the slips to selectively engage or

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release a tubular member, and a sleeve (30) attached to the moving assembly. The Guess patent does not show the various cementing tools attached to the barrel.

However, Hawkins, III shows a multi-purpose well tool including a fill-up/circulating tool, a cementing head assembly, a wiper plug assembly, and a sealing element selectively useable during wellbore cementing operations.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach a fill-up/circulating tool, a cementing head assembly, a wiper plug assembly, and/or a sealing element to the barrel of the Guess assembly as taught by Hawkins, III so that the resulting tool could be used to cement casings in a wellbore. In response to applicant's argument that Guess discloses a "spear" rather than a "tubular running tool", it is pointed out that the Guess tool is deemed capable of "inserting and selectively, internally gripping a tubular member/string" as broadly as recited in the independent claims above.

5. Claims 1-3, 6-10, 13-15, 18, 21-23, and 29-32 are allowed.


6. Claims 4, 11, 12, 16, 19, 20, and 24-28 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dean Kramer whose telephone number is (703) 308-2181.


DEAN J. KRAMER
PRIMARY EXAMINER

djk

November 21, 2000